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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/675,500 | 09/30/2003 | Allen Reeves | | 6049 |

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Arthur W. Fisher, III
Suite 316
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| EXAMINER | |
|---|---|
| SAGER, MARK ALAN | |
| ART UNIT | PAPER NUMBER |
| 3714 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 03/28/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/675,500 | REEVES, ALLEN | |
| | Examiner | Art Unit | |
| | M. A. Sager | 3712 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *13 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

*Information Disclosure Statement*

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

*Specification*

2. The substitute specification filed Jan 13, 2004 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: failure to provide marked up copy and/or provide statement no new matter has been entered.

3. A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because per notice mailed Jan 13, 2004.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification

contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

4. The abstract of the disclosure is objected to because length exceeded. Correction is required. See MPEP § 608.01(b).

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### *Claim Objections*

6. Claim 23 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim language 'further' line 2 fails to further limit claim 22.

### *Claim Rejections - 35 USC § 112*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 5-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language 'and method' fails to specify metes and bounds of invention so as to be confusing in so far as steps of process or method appear un-defined. Further, language

'device and method' appears conflicting; however, body of claim defines invention statutorily as a machine, i.e. device, rather than a process, i.e. method. For purposes of examination, 'and method' is not limiting as being undefined with possible exception of inference of intended use.

9. Claims 7-10 recites the limitation "said wage/payment" in 5. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 5-7 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lermusiaux (6135885). Lermusiaux discloses a video game wagering device for wagering on football game (1:66-3:39, fig. 1-2) comprising a game cabinet (ref. 12), a video screen (14, 32) a selector control panel (16) a wager/payment mechanism comprises a plurality of apertures to receive payment by player and means to generate a payment signal (24, 26), a microprocessor (3:62), wherein said selector control panel comprises a plurality of selector keys to generate game selections signals including play selections (5:33-54, ref. 36) and wagering selections (34, 38), wherein said microprocessor includes game data (54, 56, 58, 60, 5:66-6:3), comprising a plurality of wager selections (34, 38), and a plurality of play selections comprises a plurality of selectable plays further includes a plurality of sets of said plurality of selectable plays (5:33-54), and a data processing section including logic receives the game selection signals from said selector control keys and payment signals from said wage/payment mechanism and to generate

display signals to be displayed on said video screen in response to input from said wager/payment mechanism, and to generate game play images on the video screen of individual selected play executed against the game plan of offensive or defensive plays and a game situation profile and display the wagering results (4:63-7:5).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 1-4 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by Lermusiaux or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lermusiaux in view of either Chichester (5772512) or Giobbi (2001/0046893). Discussion above regarding Lermusiaux is incorporated herein. Lermusiaux discloses a video game wagering device for wagering on football game (fig. 1-2) comprising a video screen (14, 32) and a selector control panel (16) including a plurality of selector control keys to selectively generate a corresponding plurality of game selection and control signals including play selection and wagering selections (20, 28, 34, 36, 38, 40), a

microprocessor (3:62) including game data (54, 56, 58, 60, 5:66-6:3), comprising a plurality of wager selections (34, 38), including a plurality of play wager selections and/or period wager selections wherein said plurality of wager selections comprises a first and second set of wagers wherein said first set of wagers is a plurality of game period wager selections and said second set of wagers is a plurality of play wager selections (4:63-7:5, ref. 34, 38), a plurality of play selections includes a plurality of sets of said play selections (5:33-54), and a game plan (5:9-32) and game situation profile (5:33-36) and a data processing section including logic (6:9-7:5, ref. 64) to receive the game selection signals from the selector control keys to generate display signals in response to the game selection signals to be displayed on the video screen (6:15-18) in response to operator input from the selection control keys and to generate a game play image on the video screen of the selected play executed against the game plan and the game situation profile and display the wagering results (4:63-7:5). Thus, Lermusiaux discloses claimed structure of gaming device including a plurality of play wager selections and a plurality of period wager selections as wager selections (34, 38). Essentially, claimed structure of play wager selections or/and period wager selections fails to differentiate from Lermusiaux wager selections in so far as Lermusiaux teaches a plurality of wager selections that is same structure for same purpose such as input keys that transmit signal indicating the placement of a wager. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the

prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is. not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Lermusiaux discloses a plurality of wager selections that teaches claimed plurality of wagers including play wager selections and/or plurality of period wager selections.

Alternatively, where play wager selections or period wager selections distinguish from Lermusiaux (which office maintains at this juncture, claim language does not differentiate), Lermusiaux fails to disclose a plurality of play wager selections and a plurality of period wager selections, as claimed. Chichester discloses an electronic football game that permits a player to wager on an individual play, on the period of play or on the game (7:55-56, 7:61-8:14, 11:30-64, figs 4-9) thereby teaching a plurality of wager selections including a plurality of play wager selections and a plurality of period wager selections, further wherein said plurality of wager selections comprises a first and second set of wagers wherein said first set of wagers is a plurality of game period wager selections and said second set of wagers is a plurality of play wager selections so as to permit game state wagering thereby increasing wagering opportunities for player or to allow wagering on game state statistics. Essentially, Chichester teaches/suggests to an artisan at a time prior to the invention, allowing a player to wager on game state statistics or to allow increased wagering opportunities such as wagering on stats in a period or on individual play or on game. Similarly, Giobbi discloses a system and method for playing virtual football wagering game on a gaming device (paragraphs 24-35, 37) that allows a user to select from a plurality of plays (paragraphs 24-29), to select a plurality of wager selections including play

wager selections (paragraphs 24-32) and period wager selections such as on the series of plays or on the game (paragraphs 30-32) thereby teaching a plurality of wager selections including a plurality of play wager selections and a plurality of period wager selections, further wherein said plurality of wager selections comprises a first and second set of wagers wherein said first set of wagers is a plurality of game period wager selections and said second set of wagers is a plurality of play wager selections so as to permit game state wagering thereby increasing wagering opportunities for player or to allow wagering on game state statistics. Thus, similarly Giobbi teaches/suggests to an artisan at a time prior to the invention, allowing a player to wager on game state statistics or to allow increased wagering opportunities such as wagering on stats in a period or on individual play or on game. Thus, it would have been obvious to an artisan at a time prior to the invention to add a plurality of play wager selections, a plurality of period wager selections, further wherein said plurality of wager selections comprises a first and second set of wagers wherein said first set of wagers is a plurality of game period wager selections and said second set of wagers is a plurality of play wager selections as taught/suggested by either Chichester or Giobbi to Lermusiaux so as to increase wagering opportunities for player or to allow wagering on game state statistics. The combination of Lermusiaux in view of either Chichester or Giobbi taken as a whole at a time prior to the invention suggests to an artisan a gaming device comprising all claimed structure/features including a plurality of play wager selections, a plurality of period wager selections, and further wherein said plurality of wager selections comprises a first and second set of wagers wherein said first set of wagers is a plurality of game period wager selections and said second set of wagers is a plurality of play wager selections to

allow a player to wager on game state statistics or to allow increased wagering opportunities such as wagering on stats in a period or on individual play or on game.

15. Claims 11-14, 16-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lermusiaux in view of Chichester. Lermusiaux discloses claimed gaming device (supra) including a cabinet (12), video screen (14, 32), selector control panel (16), wager/payout mechanism (34, 38), microprocessor (3:62), a plurality of selector keys to generate a corresponding plurality of game selections including play selection (36) and wagering selection (34, 38), wagering and display or viewing control signals fed to the microprocessor (4:63-7:5), a plurality of game control keys (36, 40) to control the game including play selection (36) and plurality of wagering keys to select the amount of wagers (34, 38) including displaying a payoff or odds display (30), money available (28), wager key (34, 38), money wagered key (34, 38 or implicit to display amount wagered); but fails to disclose a plurality of display keys to selectively display a corresponding plurality of menus or game information/data (clm 11), comprises a payoff or odds menu key, a money available/pending wager status key, a proposition wager menu key and a money wagered key (clm 13), a game pointer such as a cursor control (clm 11, 14). Essentially, Lermusiaux lacks menu display key functionality and cursor control claimed. Also, discussion above regarding play wager selections and period wager selections is incorporated herein. The play wager selections and period wager selections are proposition wagers or opportunity (i.e. side) bets. Window display with menu selections forming multiple windows is well known operating system that permits user selection of data to be displayed thereby permitting user control of what/when data is viewed. Chichester discloses an electronic football game that uses window format and use of cursor control such as from a keyboard or

mouse to select window area for input (5:38-44, fig. 1-2, 4-9). Thus, it would have been obvious to an artisan at a time prior to the invention to add a plurality of display keys to selectively display a corresponding plurality of menus or game information/data, comprises a payoff or odds menu key, a money available/pending wager status key, a proposition wager menu key and a money wagered key, a game pointer such as a cursor control as suggested/taught by Chichester to Lermusiaux so as to permit player to select what/when desired data to be viewed.

16. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lermusiaux in view of Chichester as applied to claim 11 above, and further in view of Giobbi (20010046893). Lermusiaux in view of Chichester discloses a gaming device comprising claimed features (sic) including a currency receptacle (26), a coin receptacle (24) and a cash return payout (20, 22) except a credit card slot and credit card keypad. Gaming device having credit card slot and a keypad is notoriously well known since GCB allowed cashless play. Giobbi discloses gaming device for virtual football wagering game comprising a credit card slot and a keypad for cashless play (paragraphs 35, 37). Thus, it would have been obvious to an artisan at a time prior to the invention to add a credit card slot and credit card key pad as notoriously well known or as taught/suggested by Giobbi to Lermusiaux in view of Chichester to allow cashless play for user convenience so as not require input/carrying of cash. It is further noted Giobbi also teaches play selection from a plurality of plays or formations, outcome determination, and a plurality of wagering selection for proposition wagering (paragraphs 24-37, sic).

***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M. A. Sager
Primary Examiner
Art Unit 3712

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